

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Patrick A. Aliffi, *et al.*
Patent No.: 7,536,346
Serial No.: 10/021,468
Issued: May 19, 2009
Filing Date: October 29, 2001
For: SYSTEM AND METHOD FOR FACILITATING
RECIPROCATIVE SMALL BUSINESS FINANCIAL
INFORMATION EXCHANGES

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Sir:

This paper is a request for reconsideration of the Decision Dismissing Applicants' Request for Reconsideration of Patent Term Adjustment under 37 CFR 1.705 mailed on July 20, 2009. This request is being submitted in view of the Federal Circuit's decision in *Wyeth v. Kappos*, No. 2009-1120, 2010 WL 27184 (Fed. Cir. Jan. 7, 2010).

1. The Patentee filed a Communication Regarding Patent Term Adjustment (PTA) Indicated in Notice of Allowance on January 30, 2009. The Patentee stated the belief that the correct total PTA due was 1633 days. A copy of this submission is provided in **Exhibit A** to this paper.

2. In response, the United States Patent and Trademark Office (PTO) issued, on April 16, 2009, a decision that the communication was held in abeyance until after the actual date of patenting. A copy of this decision is provided in **Exhibit B** to this paper.

3. The patent issued May 19, 2009. The face of the patent sets forth a PTA of 795 days, the same amount of PTA set forth in the Notice of Allowance. It is believed that this total PTA is still erroneous and that the correct total PTA is 1633 days.

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

4. The Patentee submitted a Renewed Request for Reconsideration of Patent Term Adjustment Determination under 37 C.F.R. § 1.705(d) on June 25, 2009. A copy of this submission is provided in **Exhibit C** to this paper.

5. The PTO mailed on July 20, 2009 a Decision dismissing Patentee's request for reconsideration. The Decision dismissed the Patentee's request because the Patentee's interpretation of the period of overlap was found inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. § 154(b)(2)(A). A copy of this Decision is provided in **Exhibit D** to this paper.

6. On January 7, 2010, the United States Court of Appeals for the Federal Circuit decided *Wyeth*. In *Wyeth*, the Federal Circuit rejected the interpretation of 35 U.S.C. § 154(b)(2)(A) applied by the PTO in dismissing the Patentee's request for reconsideration. Instead, the Federal Circuit affirmed the interpretation applied by the Patentee in contending that the proper PTA due for the present patent is 1633 days.

7. In view of *Wyeth*, the Patentee hereby respectfully submits this request for reconsideration petition requesting that the PTO award the Patentee the proper PTA due for the present patent, which the Patentee believes is 1633 days. The Patentee respectfully submits that fundamental fairness should result in an award of a proper PTA application to this patent. The Patentee diligently brought to the Office's attention via petitions its contention that the PTA awarded was incorrect. The Office dismissed the Patentee's petition on reasoning that was rejected by the Federal Circuit in the *Wyeth* decision. Accordingly, the Patentee kindly requests that the Office grant the proper PTA due for this patent.

8. No fees are believed due for this request based on the payment of the fees under 37 C.F.R. § 1.18(e). But, the Commissioner is authorized to charge said fees to Deposit Account No. 11-0855 if any fees are due.

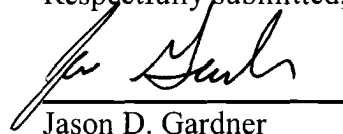
U.S. Patent No. 7,536,346

Issued: May 19, 2009

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Date:

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jason D. Gardner", is written over a horizontal line.

Jason D. Gardner

Reg. No. 58,180

KILPATRICK STOCKTON LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GEORGIA 30309
404.815.6500 PHONE
404.815.6555 FAX

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Patrick A. Aliffi *et al.*
Ser. No. : 10/021,468
Filing Date : October 29, 2001
For : SYSTEM AND METHOD FOR FACILITATING
RECIPROCATIVE SMALL BUSINESS
FINANCIAL INFORMATION
Examiner : Mamon A. Obeid
Art Unit : 3621
Atty. Docket : E0019/258247

Mail Stop: Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Communication Regarding Patent Term Adjustment (PTA)
Indicated in Notice of Allowance

Sir:

1. A Notice of Allowance was mailed on October 30, 2008 for the present application. One of the attachments to the Notice of Allowance was a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) that indicated that the total PTA to date is 795 days. It is believed that this total is erroneous and that the correct total PTA to date is 1633 days.

2. The determination of the total PTA of 795 days is erroneous because the US Patent & Trademark Office failed to account for one additional Patent Office delay. The PTO delay periods should have their days added together in accordance with the reasoning in *Wyeth et al. v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008). The number of PTA credits of 876 days for PTO delay under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a)(1) that is set forth on the enclosed PTA History (Exhibit A) is correct, however, it only accounts for one of the delays of the PTO. The other delay

CERTIFICATE OF ELECTRONIC TRANSMISSION
I hereby certify that this submission is being filed via EFS
Web with the U.S. Patent and Trademark Office on January 30, 2009.
s/Angela M. Rossi/
Angela M. Rossi

warrants an additional PTA credit of 797 days for PTO delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b). Because these two periods of delay do not overlap, Applicants are entitled to the sum of these two periods. Accordingly, a total PTA credit of 1673 days (*i.e.*, 876 days + 797 days) is appropriate based upon the PTO delay. The total number of PTA debits of 40 days for applicant delay that is set forth on the enclosed PTA History (Exhibit A) is correct. Thus, the correct total PTA to date is 1633 days (*i.e.*, 1673 days – 40 days).

Thus, Applicants believe that the total PTA credit for PTO delay is 1673 days, the total PTA debit for applicant delay is 40 days, and the total PTA under § 1.703(f) is 1633 days.

3. In accordance with 1.705(b), this application for patent term adjustment is filed no later than the payment of the issue fee but after the date of mailing of the notice of allowance.

4. The following statements are required by 37 C.F.R. § 1.705(b)(2)(i).

- i) The correct total PTA credit is 1673 days.
- ii) The basis for the 876 days PTA credit is under §§ 1.702(a)(1) is due to the PTO's failure to mail a notification under 35 U.S.C. § 132 or a notice of allowance within 14 months of the application's filing date. The basis for the 797 days is under § 1.702(b) and is due to the PTO's failure to issue a patent within three years of the filing date.

5. The following statements are required by 37 C.F.R. § 1.705(b)(2)(ii).

- i) The relevant dates as specified in § 1.703(a) for one part of the PTA credit are as follows:

(a) The date of December 30, 2002, which is the date that is the day after fourteen months after the date on which the application was filed under 35 U.S.C. § 111(a). Thus, this period of delay runs from December 30, 2002 to May 23, 2005. This period of delay is 876 days.

Thus, the total period of delay for this part of the PTA credit is 876.

- ii) The relevant dates as specified in § 1.703(b) for the other part of the PTA credit are as follows: the date of October 30, 2004, which is the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) and the date of January 4, 2007, which is the date that a request for continued examination of the application under 35 U.S.C. § 132(b) was filed. Thus, the period of delay runs from October 30, 2004 to January 4, 2007 on which the request for continued examination was filed.

Thus, the total period of delay for this part of the PTA credit is 797 days.

- iii) The total PTA under § 1.703(f) is 1633 days, which is the total PTA credits for PTO delay of 876 days plus 797 days less the total PTA debits for applicant delay of 40 days.

6. Any patent granted on this application is not subject to a terminal disclaimer. See 37 C.F.R. § 1.705(b)(2)(iii).

7. The following statements are required by 37 C.F.R. § 1.705(b)(2)(iv)(A):

- i) The Information Disclosure Statement filed September 2, 2005 was filed after the initial response and is considered a supplemental reply. Under § 1.704(b)(8), the period of adjustment for delay associated with this reply begins on the day of filing of the Response on August 23, 2005 and ends on the date the Information Disclosure Statement was filed. Thus, the period of delay runs from August 23, 2005 to September 2, 2005. This period of delay is 10 days.
- ii) The Request for Continued Examination filed January 4, 2007 was filed after the three month period for filing a response.

Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of mailing of the Office Action on September 5, 2006 and ends on the date the reply was filed. Thus, the period of delay runs from December 6, 2006 to January 4, 2007. This period of delay is 30 days. Thus, the total period of delay for applicant delay is 40 days (10 days + 30).

The Commissioner is authorized to charge the firm's credit card in the amount of \$200.00 pursuant to 37 CFR 1.18(e). The Commissioner is authorized to charge any additional fees that may be due or credit any overpayment to Deposit Account No. 11-0855. If there any issues concerning this Communication that can be resolved via a telephone communication, the Office is invited to contact the undersigned.

Respectfully submitted,

/Jason D. Gardner 58180/
Jason D. Gardner
Reg. No. 58180
Attorney for Assignee

KILPATRICK STOCKTON LLP
1100 Peachtree Street, Suite 2800
Atlanta, Georgia 30309
Telephone: 404-815-6500
Facsimile: 404-815-6555
Attorney Docket No. 41577/295089

Encl.: Exhibit A - Copy of PTA History for Application No. 10/021,468 printed from PAIR on January 21, 2009

EXHIBIT A.

10/021,468	SYSTEM AND METHOD FOR FACILITATING RECIPROCATIVE SMALL BUSINESS FINANCIAL INFORMATION EXCHANGES	01-21-2009::09:10:48
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Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/021,468

Filing or 371(c) Date:	10-29-2001	USPTO Delay (PTO) Delay (days):	893
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	98
Post-Issue Petitions (days):	+0	Total PTA (days):	795
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
10-30-2008	Mail Notice of Allowance		
10-27-2008	Document Verification		
10-27-2008	Examiner's Amendment Communication		
10-27-2008	Notice of Allowance Data Verification Completed		
08-21-2008	Date Forwarded to Examiner		
08-21-2008	Date Forwarded to Examiner		
08-15-2008	Request for Continued Examination (RCE)		58
08-21-2008	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		↑
08-15-2008	Request for Extension of Time - Granted		↑
08-15-2008	Workflow - Request for RCE - Begin		↑
03-06-2008	Miscellaneous Incoming Letter		↑
02-29-2008	Miscellaneous Incoming Letter		↑
03-18-2008	Mail Final Rejection (PTOL - 326)	17	
03-14-2008	Final Rejection	↑	
03-05-2008	Case Docketed to Examiner in GAU	↑	
03-05-2008	Mail Appeals conf. Proceed to BPAI	↑	
02-28-2008	Pre-Appeals Conference Decision - Proceed to BPAI	↑	
02-19-2008	Case Docketed to Examiner in GAU	↑	
12-26-2007	Request for Pre-Appeal Conference Filed	↑	
12-29-2007	Date Forwarded to Examiner	↑	
12-26-2007	Amendment/Argument after Notice of Appeal	↑	
11-26-2007	Notice of Appeal Filed	↑	
11-26-2007	Mail Advisory Action (PTOL - 303)	↑	
11-24-2007	Advisory Action (PTOL-303)	↑	
11-05-2007	Date Forwarded to Examiner	↑	
11-01-2007	Amendment after Final Rejection	↑	
09-24-2007	Mail Final Rejection (PTOL - 326)		
09-12-2007	Final Rejection		
07-10-2007	Date Forwarded to Examiner		
07-03-2007	Response after Non-Final Action		

04-04-2007	Mail Non-Final Rejection	
03-26-2007	Non-Final Rejection	
11-06-2006	Information Disclosure Statement considered	
01-09-2007	Miscellaneous Incoming Letter	
01-13-2007	Date Forwarded to Examiner	
01-13-2007	Date Forwarded to Examiner	
01-04-2007	Request for Continued Examination (RCE)	30
01-13-2007	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	↑
01-04-2007	Request for Extension of Time - Granted	↑
01-04-2007	Workflow - Request for RCE - Begin	↑
12-11-2006	Mail Advisory Action (PTOL - 303)	↑
12-04-2006	Advisory Action (PTOL-303)	↑
11-06-2006	Reference capture on IDS	↑
11-06-2006	Information Disclosure Statement (IDS) Filed	↑
11-06-2006	Information Disclosure Statement (IDS) Filed	↑
11-16-2006	Date Forwarded to Examiner	↑
11-06-2006	Amendment after Final Rejection	↑
11-06-2006	Request for Foreign Priority (Priority Papers May Be Included)	↑
09-05-2006	Mail Final Rejection (PTOL - 326)	↑
08-28-2006	Final Rejection	
06-23-2006	Date Forwarded to Examiner	
06-20-2006	Response after Non-Final Action	
04-28-2006	Case Docketed to Examiner in GAU	
03-20-2006	Mail Non-Final Rejection	
03-10-2006	Non-Final Rejection	
09-02-2005	Information Disclosure Statement considered	
02-14-2005	Information Disclosure Statement considered	
01-13-2006	Date Forwarded to Examiner	
01-10-2006	Response to Election / Restriction Filed	
01-10-2006	Request for Extension of Time - Granted	
11-04-2005	Mail Restriction Requirement	
11-02-2005	Requirement for Restriction / Election	
09-02-2005	Reference capture on IDS	
09-02-2005	Information Disclosure Statement (IDS) Filed	10
09-02-2005	Information Disclosure Statement (IDS) Filed	
09-01-2005	Date Forwarded to Examiner	↑
08-23-2005	Response after Non-Final Action	↑
05-23-2005	Mail Non-Final Rejection	876
05-19-2005	Non-Final Rejection	↑
05-13-2005	Case Docketed to Examiner in GAU	↑

02-14-2005	Reference capture on IDS	↑
02-14-2005	Information Disclosure Statement (IDS) Filed	↑
02-14-2005	Information Disclosure Statement (IDS) Filed	↑
05-10-2004	IFW TSS Processing by Tech Center Complete	↑
05-29-2002	Case Docketed to Examiner in GAU	↑
04-23-2002	Case Docketed to Examiner in GAU	↑
03-29-2002	Application Dispatched from OIPE	↑
03-20-2002	Application Is Now Complete	↑
02-12-2002	Additional Application Filing Fees	↑
02-12-2002	Small Entity Statement (37 CFR 1.27)	↑
02-12-2002	Applicant has submitted new drawings to correct Corrected Papers problems	↑
01-15-2002	Corrected Paper	↑
12-31-2001	IFW Scan & PACR Auto Security Review	↑
10-29-2001	Initial Exam Team nn	↑

Close Window

EXHIBIT B



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1480
ALEXANDRIA, VA 22313-1480
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JOHN S. PRATT, ESQ.
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA GA 30309

MAILED

APR 16 2009

OFFICE OF PETITIONS

In re Application of :
ALIFFI et al. :
Application No. 10/021,468 : ON APPLICATION FOR
Filed: October 29, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. E0019/258247 :

This is in response to the Communication Regarding Patent Term Adjustment (PTA) indicated in Notice of Allowance filed January 30, 2009. Applicant requests that the determination of patent term adjustment be corrected from 795 days to 1633 days. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within three years. See 37 CFR 1.703(b). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined. Accordingly, it is still too soon to make a determination as to the correctness

of any period of adjustment that will or will not be entered pursuant to § 1.703(b)).

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within three years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

It is acknowledged that applicant is correct that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including -

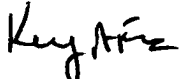
(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is noted that a Request for Continued Examination (RCE) was filed in this application on January 4, 2007.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney, Christina Tartera Donnell, at (571) 272-3211.



Kery A. Fries
Senior Legal Advisor
Office Patent Legal Administration

EXHIBIT C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Patrick A. Aliffi, et al.
Patent No.: 7,536,346
Serial No.: 10/021,468
Issued: May 19, 2009
Filing Date: October 29, 2001
For: SYSTEM AND METHOD FOR FACILITATING
RECIPROCATIVE SMALL BUSINESS FINANCIAL
INFORMATION EXCHANGES

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM
ADJUSTMENT DETERMINATION

Sir:

1. Applicants filed a Communication Regarding Patent Term Adjustment (PTA) Indicated in Notice of Allowance (hereinafter "First Communication") on January 30, 2009, a copy of which is attached hereto as Attachment A. In the First Communication, Applicants asserted that the PTA of 795 days that was set forth in the Notice of Allowance, mailed October 30, 2008, was erroneous. Applicants stated the belief that the correct total PTA due was 1633 days.

2. In response to the First Communication, the United States Patent and Trademark Office issued, on April 16, 2009, a decision **held in abeyance** until after the actual patent date (hereinafter "USPTO Response"). A copy of the USPTO Response is attached hereto as Attachment B in accordance with page 2 of the USPTO Response.

RENEWED REQUEST FOR CONSIDERATION OF
PATENT TERM ADJUSTMENT DETERMINATION

3. The actual patent issued May 19, 2009. The face of the patent sets forth a PTA of 795 days, the same amount of PTA set forth in the Notice of Allowance. It is believed that this total is still erroneous and that the correct total PTA is 1633 days.

4. Accordingly, Applicants submit this Renewed Request for Reconsideration of Patent Term Adjustment Determination under 37 C.F.R. § 1.705(d) and pursuant to page 2 of the USPTO response, requesting that the United States Patent & Trademark Office reconsider and correct the PTA due.

5. The determination of the total PTA of 795 days is erroneous because the United States Patent & Trademark Office failed to account for one additional Patent Office delay. The PTO delay periods should have their days added together in accordance with the reasoning in *Wyeth et al. v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008). The number of PTA credits of 876 days for PTO delay under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a)(1) that is set forth on the PTA History (*See* Exhibit A of Attachment A) is correct, however, it only accounts for one of the delays of the PTO. The other delay warrants an additional PTA credit of 797 days for PTO delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b). Because these two periods of delay do not overlap, Applicants are entitled to the sum of these two periods. Accordingly, a total PTA credit of 1673 days (*i.e.*, 876 days + 797 days) is appropriate based upon the PTO delay. The total number of PTA debits of 40 days for applicant delay that is set forth on the PTA History (*See* Exhibit A of Attachment A) is correct. Thus, the correct total PTA to date is 1633 days (*i.e.*, 1673 days – 40 days).

6. Thus, Applicants believe that the total PTA credit for PTO delay is 1673 days, the total PTA debit for applicant delay is 40 days, and the total PTA under § 1.703(f) is 1633 days.

7. In accordance with 1.705(d), this application for patent term adjustment is filed within two (2) months from the issue date of the patent.

8. The following statements are required by 37 C.F.R. § 1.705(b)(2)(i).

i) The correct total PTA credit is 1673 days.

U.S. Patent No. 7,536,346
Issued: May 19, 2009
RENEWED REQUEST FOR CONSIDERATION OF
PATENT TERM ADJUSTMENT DETERMINATION

ii) The basis for the 876 days PTA credit is under §§ 1.702(a)(1) is due to the PTO's failure to mail a notification under 35 U.S.C. § 132 or a notice of allowance within 14 months of the application's filing date. The basis for the 797 days is under § 1.702(b) and is due to the PTO's failure to issue a patent within three years of the filing date.

9. The following statements are required by 37 C.F.R. § 1.705(b)(2)(ii).

i) The relevant dates as specified in § 1.703(a) for one part of the PTA credit are as follows:

(a) The date of December 30, 2002, which is the date that is the day after fourteen months after the date on which the application was filed under 35 U.S.C. § 111(a). Thus, this period of delay runs from December 30, 2002 to May 23, 2005. This period of delay is 876 days.

Thus, the total period of delay for this part of the PTA credit is 876.

ii) The relevant dates as specified in § 1.703(b) for the other part of the PTA credit are as follows: the date of October 30, 2004, which is the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) and the date of January 4, 2007, which is the date that a request for continued examination of the application under 35 U.S.C. § 132(b) was filed. Thus, the period of delay runs from October 30, 2004 to January 4, 2007 on which the request for continued examination was filed.

Thus, the total period of delay for this part of the PTA credit is 797 days.

iii) The total PTA under § 1.703(f) is 1633 days, which is the total PTA credits for PTO delay of 876 days plus 797 days less the total PTA debits for applicant delay of 40 days.

10. The patent is not subject to a terminal disclaimer. See 37 C.F.R. § 1.705(b)(2)(iii).

11. The following statements are required by 37 C.F.R. § 1.705(b)(2)(iv)(A):

i) The Information Disclosure Statement filed September 2, 2005 was filed after the initial response and is considered a supplemental reply. Under

U.S. Patent No. 7,536,346
Issued: May 19, 2009
RENEWED REQUEST FOR CONSIDERATION OF
PATENT TERM ADJUSTMENT DETERMINATION

§ 1.704(b)(8), the period of adjustment for delay associated with this reply begins on the day of filing of the Response on August 23, 2005 and ends on the date the Information Disclosure Statement was filed. Thus, the period of delay runs from August 23, 2005 to September 2, 2005. This period of delay is 10 days.

ii) The Request for Continued Examination filed January 4, 2007 was filed after the three month period for filing a response. Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of mailing of the Office Action on September 5, 2006 and ends on the date the reply was filed. Thus, the period of delay runs from December 6, 2006 to January 4, 2007. This period of delay is 30 days.

Thus, the total period of delay for applicant delay is 40 days (10 days + 30).

12. No fees are believed due for this renewed request based on the payment of the fees under 37 C.F.R. § 1.18(e) with the submission of the First Communication, and the United States Patent and Trademark Office's statement in the USPTO Response that no further fees are required. See USPTO Response, pages 2-3.

13. Applicants respectfully request the PTA determined by the United States Patent and Trademark Office be reconsidered and corrected.

Respectfully submitted,

Date: June 25, 2009

/Jason D. Gardner 58180/

Jason D. Gardner
Reg. No. 58180

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ATTACHMENT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Patrick A. Aliffi *et al.*
Ser. No. : 10/021,468
Filing Date : October 29, 2001
For : SYSTEM AND METHOD FOR FACILITATING
RECIPROCATIVE SMALL BUSINESS
FINANCIAL INFORMATION
Examiner : Marmon A. Obeid
Art Unit : 3621
Atty. Docket : E0019/258247

Mail Stop: Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Communication Regarding Patent Term Adjustment (PTA)
Indicated in Notice of Allowance

Sir:

1. A Notice of Allowance was mailed on October 30, 2008 for the present application. One of the attachments to the Notice of Allowance was a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) that indicated that the total PTA to date is 795 days. It is believed that this total is erroneous and that the correct total PTA to date is 1633 days.

2. The determination of the total PTA of 795 days is erroneous because the US Patent & Trademark Office failed to account for one additional Patent Office delay. The PTO delay periods should have their days added together in accordance with the reasoning in *Wyeth et al. v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008). The number of PTA credits of 876 days for PTO delay under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a)(1) that is set forth on the enclosed PTA History (Exhibit A) is correct, however, it only accounts for one of the delays of the PTO. The other delay

CERTIFICATE OF ELECTRONIC TRANSMISSION
I hereby certify that this submission is being filed via EFS
Web with the U.S. Patent and Trademark Office on January 30, 2009.
/s/ Angela M. Rossi/
Angela M. Rossi

warrants an additional PTA credit of 797 days for PTO delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b). Because these two periods of delay do not overlap, Applicants are entitled to the sum of these two periods. Accordingly, a total PTA credit of 1673 days (*i.e.*, 876 days + 797 days) is appropriate based upon the PTO delay. The total number of PTA debits of 40 days for applicant delay that is set forth on the enclosed PTA History (Exhibit A) is correct. Thus, the correct total PTA to date is 1633 days (*i.e.*, 1673 days – 40 days).

Thus, Applicants believe that the total PTA credit for PTO delay is 1673 days, the total PTA debit for applicant delay is 40 days, and the total PTA under § 1.703(f) is 1633 days.

3. In accordance with 1.705(b), this application for patent term adjustment is filed no later than the payment of the issue fee but after the date of mailing of the notice of allowance.

4. The following statements are required by 37 C.F.R. § 1.705(b)(2)(i).

- i) The correct total PTA credit is 1673 days.
- ii) The basis for the 876 days PTA credit is under §§ 1.702(a)(1) is due to the PTO's failure to mail a notification under 35 U.S.C. § 132 or a notice of allowance within 14 months of the application's filing date. The basis for the 797 days is under § 1.702(b) and is due to the PTO's failure to issue a patent within three years of the filing date.

5. The following statements are required by 37 C.F.R. § 1.705(b)(2)(ii).

- i) The relevant dates as specified in § 1.703(a) for one part of the PTA credit are as follows:

(a) The date of December 30, 2002, which is the date that is the day after fourteen months after the date on which the application was filed under 35 U.S.C. § 111(a). Thus, this period of delay runs from December 30, 2002 to May 23, 2005. This period of delay is 876 days.

Thus, the total period of delay for this part of the PTA credit is 876.

- ii) The relevant dates as specified in § 1.703(b) for the other part of the PTA credit are as follows: the date of October 30, 2004, which is the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) and the date of January 4, 2007, which is the date that a request for continued examination of the application under 35 U.S.C. § 132(b) was filed. Thus, the period of delay runs from October 30, 2004 to January 4, 2007 on which the request for continued examination was filed.

Thus, the total period of delay for this part of the PTA credit is 797 days.

- iii) The total PTA under § 1.703(f) is 1633 days, which is the total PTA credits for PTO delay of 876 days plus 797 days less the total PTA debits for applicant delay of 40 days.

6. Any patent granted on this application is not subject to a terminal disclaimer. See 37 C.F.R. § 1.705(b)(2)(iii).

7. The following statements are required by 37 C.F.R. § 1.705(b)(2)(iv)(A):

- i) The Information Disclosure Statement filed September 2, 2005 was filed after the initial response and is considered a supplemental reply. Under § 1.704(b)(8), the period of adjustment for delay associated with this reply begins on the day of filing of the Response on August 23, 2005 and ends on the date the Information Disclosure Statement was filed. Thus, the period of delay runs from August 23, 2005 to September 2, 2005. This period of delay is 10 days.
- ii) The Request for Continued Examination filed January 4, 2007 was filed after the three month period for filing a response.

Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of mailing of the Office Action on September 5, 2006 and ends on the date the reply was filed.

Thus, the period of delay runs from December 6, 2006 to January 4, 2007. This period of delay is 30 days.

Thus, the total period of delay for applicant delay is 40 days (10 days + 30).

The Commissioner is authorized to charge the firm's credit card in the amount of \$200.00 pursuant to 37 CFR 1.18(e). The Commissioner is authorized to charge any additional fees that may be due or credit any overpayment to Deposit Account No. 11-0855. If there any issues concerning this Communication that can be resolved via a telephone communication, the Office is invited to contact the undersigned.

Respectfully submitted,

/Jason D. Gardner 58180/
Jason D. Gardner
Reg. No. 58180
Attorney for Assignee

KILPATRICK STOCKTON LLP
1100 Peachtree Street, Suite 2800
Atlanta, Georgia 30309
Telephone: 404-815-6500
Facsimile: 404-815-6555
Attorney Docket No. 41577/295089

Encl.: Exhibit A - Copy of PTA History for Application No. 10/021,468 printed from PAIR on January 21, 2009

EXHIBIT A.

10/021,468	SYSTEM AND METHOD FOR FACILITATING RECIPROCATIVE SMALL BUSINESS FINANCIAL INFORMATION EXCHANGES	01-21-2009::09:10:48
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Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/021,468

Filing or 371(c) Date:	10-29-2001	USPTO Delay (PTO) Delay (days):	893
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	98
Post-Issue Petitions (days):	+0	Total PTA (days):	795
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
10-30-2008	Mail Notice of Allowance		
10-27-2008	Document Verification		
10-27-2008	Examiner's Amendment Communication		
10-27-2008	Notice of Allowance Data Verification Completed		
08-21-2008	Date Forwarded to Examiner		
08-21-2008	Date Forwarded to Examiner		
08-15-2008	Request for Continued Examination (RCE)		58
08-21-2008	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		↑
08-15-2008	Request for Extension of Time - Granted		↑
08-15-2008	Workflow - Request for RCE - Begin		↑
03-06-2008	Miscellaneous Incoming Letter		↑
02-29-2008	Miscellaneous Incoming Letter		↑
03-18-2008	Mail Final Rejection (PTOL - 326)	17	
03-14-2008	Final Rejection	↑	
03-05-2008	Case Docketed to Examiner in GAU	↑	
03-05-2008	Mail Appeals conf. Proceed to BPAI	↑	
02-28-2008	Pre-Appeals Conference Decision - Proceed to BPAI	↑	
02-19-2008	Case Docketed to Examiner in GAU	↑	
12-26-2007	Request for Pre-Appeal Conference Filed	↑	
12-29-2007	Date Forwarded to Examiner	↑	
12-26-2007	Amendment/Argument after Notice of Appeal	↑	
11-26-2007	Notice of Appeal Filed	↑	
11-26-2007	Mail Advisory Action (PTOL - 303)	↑	
11-24-2007	Advisory Action (PTOL-303)	↑	
11-05-2007	Date Forwarded to Examiner	↑	
11-01-2007	Amendment after Final Rejection	↑	
09-24-2007	Mail Final Rejection (PTOL - 326)		
09-12-2007	Final Rejection		
07-10-2007	Date Forwarded to Examiner		
07-03-2007	Response after Non-Final Action		

04-04-2007	Mail Non-Final Rejection	
03-26-2007	Non-Final Rejection	
11-06-2006	Information Disclosure Statement considered	
01-09-2007	Miscellaneous Incoming Letter	
01-13-2007	Date Forwarded to Examiner	
01-13-2007	Date Forwarded to Examiner	
01-04-2007	Request for Continued Examination (RCE)	30
01-13-2007	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	↑
01-04-2007	Request for Extension of Time - Granted	↑
01-04-2007	Workflow - Request for RCE - Begin	↑
12-11-2006	Mail Advisory Action (PTOL - 303)	↑
12-04-2006	Advisory Action (PTOL-303)	↑
11-06-2006	Reference capture on IDS	↑
11-06-2006	Information Disclosure Statement (IDS) Filed	↑
11-06-2006	Information Disclosure Statement (IDS) Filed	↑
11-16-2006	Date Forwarded to Examiner	↑
11-06-2006	Amendment after Final Rejection	↑
11-06-2006	Request for Foreign Priority (Priority Papers May Be Included)	↑
09-05-2006	Mail Final Rejection (PTOL - 326)	↑
08-28-2006	Final Rejection	
06-23-2006	Date Forwarded to Examiner	
06-20-2006	Response after Non-Final Action	
04-28-2006	Case Docketed to Examiner in GAU	
03-20-2006	Mail Non-Final Rejection	
03-10-2006	Non-Final Rejection	
09-02-2005	Information Disclosure Statement considered	
02-14-2005	Information Disclosure Statement considered	
01-13-2006	Date Forwarded to Examiner	
01-10-2006	Response to Election / Restriction Filed	
01-10-2006	Request for Extension of Time - Granted	
11-04-2005	Mail Restriction Requirement	
11-02-2005	Requirement for Restriction / Election	
09-02-2005	Reference capture on IDS	
09-02-2005	Information Disclosure Statement (IDS) Filed	10
09-02-2005	Information Disclosure Statement (IDS) Filed	
09-01-2005	Date Forwarded to Examiner	↑
08-23-2005	Response after Non-Final Action	↑
05-23-2005	Mail Non-Final Rejection	876
05-19-2005	Non-Final Rejection	↑
05-13-2005	Case Docketed to Examiner in GAU	↑

02-14-2005	Reference capture on IDS	↑
02-14-2005	Information Disclosure Statement (IDS) Filed	↑
02-14-2005	Information Disclosure Statement (IDS) Filed	↑
05-10-2004	IFW TSS Processing by Tech Center Complete	↑
05-29-2002	Case Docketed to Examiner in GAU	↑
04-23-2002	Case Docketed to Examiner in GAU	↑
03-29-2002	Application Dispatched from OIPE	↑
03-20-2002	Application Is Now Complete	↑
02-12-2002	Additional Application Filing Fees	↑
02-12-2002	Small Entity Statement (37 CFR 1.27)	↑
02-12-2002	Applicant has submitted new drawings to correct Corrected Papers problems	↑
01-15-2002	Corrected Paper	↑
12-31-2001	IFW Scan & PACR Auto Security Review	↑
10-29-2001	Initial Exam Team nn	↑

Close Window

ATTACHMENT B



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SUITE 2800
ATLANTA GA 30309

MAILED

APR 16 2009

OFFICE OF PETITIONS

In re Application of :
ALIFFI et al. :
Application No. 10/021,468 : ON APPLICATION FOR
Filed: October 29, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. E0019/258247 :

This is in response to the Communication Regarding Patent Term Adjustment (PTA) indicated in Notice of Allowance filed January 30, 2009. Applicant requests that the determination of patent term adjustment be corrected from 795 days to 1633 days. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within three years. See 37 CFR 1.703(b). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined. Accordingly, it is still too soon to make a determination as to the correctness

of any period of adjustment that will or will not be entered pursuant to § 1.703(b)).

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within three years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

It is acknowledged that applicant is correct that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including -

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is noted that a Request for Continued Examination (RCE) was filed in this application on January 4, 2007.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney, Christina Tartera Donnell, at (571) 272-3211.

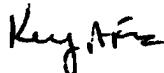

Kery A. Fries
Senior Legal Advisor
Office Patent Legal Administration

EXHIBIT D



UNITED STATES PATENT AND TRADEMARK OFFICE

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SUITE 2800
ATLANTA GA 30309

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JUL 20 2009

OFFICE OF PETITIONS

In re Patent No. 7,536,346	:	
ALIFFI et al.	:	DECISION DISMISSING
Issue Date: May 19, 2009	:	REQUEST FOR
Application No. 10/021,468	:	RECONSIDERATION
Filed: October 29, 2001	:	OF PATENT TERM ADJUSTMENT
Atty. Docket No. E0019/258247	:	UNDER 37 CFR 1.705

This is in response to the "RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION" filed June 25, 2009, which is properly treated under 37 CFR 1.705(d). Patentees request that the determination of patent term adjustment be corrected from seven hundred ninety-five (795) days to one thousand six hundred thirty-three (1,633) days.

The request for reconsideration of patent term adjustment is **DISMISSED** with respect to making any change in the patent term adjustment determination under 35 U.S.C. 154(b) of 795 days.

BACKGROUND

This application was filed on October 29, 2001. On January 4, 2007, applicants filed the first request for continued examination (RCE) in the application. On October 30, 2008, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application, stating that patent term adjustment to date was 795 days.¹ On May 19, 2009,

¹ 893 days of Office delay was reduced by 98 days of applicant delay for a patent term adjustment of 795 days. Applicants did not file a request for reconsideration of this initial determination seeking reinstatement of any part of the term **reduced pursuant to 37 CFR 1.704(a)**.

the application matured into U.S. Patent No. 7,536,346, with a revised patent term adjustment of 795 days.

On June 25, 2009, patentees timely submitted this request for reconsideration of patent term adjustment within two months of the issue date of the patent. See 37 CFR 1.705(d). Patentees contend:

The determination of the total PTA of 795 days is erroneous because the United States Patent & Trademark Office failed to account for one additional Patent Office delay. The PTO delay periods should have their days added together in accordance with the reasoning in *Wyeth et al. v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008). The number of PTA credits of 876 days for PTO delay under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a)(1) that is set forth on the enclosed PTA History (Exhibit A) is correct, however, it only accounts for one of the delays of the PTO. The other delay warrants an additional PTA credit of 797 days for PTO delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b). Because these two periods of delay do not overlap, Applicants are entitled to the sum of these two periods. Accordingly, a total PTA credit of 1673 days (i. e., 876 days + 797 days) is appropriate based upon the PTO delay. The total number of PTA debits of 40 days for applicant delay that is set forth on the enclosed PTA History (Exhibit A) is correct. Thus, the correct total PTA to date is 1633 days (i.e., 1673 days - 40 days).

Thus, Applicants believe that the total PTA credit for PTO delay is 1673 days, the total PTA debit for applicant delay is 40 days, and the total PTA under § 1.703(f) is 1633 days.

Renewed Request dated 06/25/09, p. 2.

The Office agrees that as of the filing of the first RCE on January 4, 2007, the application was pending 3 years and 797 days after its filing date. However, the Office notes that 876 days² of patent term adjustment were accorded prior to the filing

² A nonfinal Office action was mailed on May 23, 2005, 14 months and 876 days after the application was filed on October 29, 2001.

of the RCE pursuant to 37 CFR 1.702(a)(1),³ and 17 days⁴ of Office delay occurred after the filing of the RCE pursuant to 37 CFR 1.702(a)(2).⁵ Lastly, the Office disagrees with patentees' calculation of applicant delay as 40 days. Patentees were properly assessed a period of delay of 58 day, pursuant to 37 CFR 1.704(b), for failing to file a reply to the final Office action of March 18, 2008, until August 15, 2008, three months and 58 days later. Accordingly, the total period of applicant delay is 98 (10 + 30 + 58) days.

OPINION

Patentees' interpretation of the period of overlap has been considered, but has been found inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A).

³ 37 CFR 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application[.]

⁴ The Office mailed a final Office action on March 18, 2008, 4 months and 17 days after the filing of the reply on November 1, 2007.

⁵ 37 CFR 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

.

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken[.]

35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*⁶ and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A), 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 54366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final*

⁶ Likewise, 37 CFR 1.703(f) provides that:

To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

Rule, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding 37 CFR 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

It is noted, however, that delays resulting in the Office's failure to meet the time frames specified in 35 U.S.C. 154(b)(1)(A) (the "fourteen-four-four-four" provisions) are not always overlapping with a delay resulting in the Office's failure to issue a patent within the three-year time frame specified in 35 U.S.C. 154(b)(1)(B) because not all application pendency time is counted toward this three-year period. See 35 U.S.C. 154(b)(1)(B)(i)-(iii).

In this instance, all application pendency time is not counted toward the three-year period. The first RCE was filed on January 4, 2007. The period subsequent to the filing of the RCE is not included in the three-year time frame specified in 35 U.S.C. 154(b)(1)(B). See 35 U.S.C. 154(b)(1)(B)(i). Thus, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period from the filing of the application on October 29, 2001, to the filing of the first RCE on January 4, 2007. Thus, only the 876 days of patent term adjustment accorded prior to

the filing of the first RCE pursuant to 37 CFR 1.702(a)(1) are considered in determining overlap. The 17 days for Office delay under 37 CFR 1.702(a)(4), occurring after the filing of the first RCE is not considered. The 797 days attributed to Office delay pursuant to 37 CFR 1.702(b) for failure to issue the patent within three years after the filing of the application is determined to overlap with the 876 days attributed to Office delay pursuant to 37 CFR 1.702(a)(1). 893 (876 + 17) days is the actual number of days issuance of the patent was delayed. Accordingly, at issuance, the Office properly entered no additional period of adjustment, having considered the 797 days of Office delay under the three-year pendency provision.

CONCLUSION

In view thereof, the Office affirms the revised determination of patent term adjustment at the time of the issuance of the patent is 795 days ((893 (876 + 17) days of Office delay - 98 (10 + 30 + 58) days of applicant delay)).

The Office acknowledges the previous submission of the \$200.00 fee set forth in 37 CFR 1.18(e) on January 30, 2009. No additional fees are required.

Telephone inquiries specific to this matter should be directed the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions